



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,615	12/30/2003	Daniel F. Justin	ZIM0763	8943
43963 7590 01/04/2010 ZIMMER TECHNOLOGY - BAKER & DANIELS 111 EAST WAYNE STREET, SUITE 800 FORT WAYNE, IN 46802				
EXAMINER				
RAMANA, ANURADHA				
ART UNIT		PAPER NUMBER		
3775				
MAIL DATE		DELIVERY MODE		
01/04/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/750,615

**Applicant(s)**

JUSTIN ET AL.

**Examiner**

Anu Ramana

**Art Unit**

3775

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 32, 33, 35-38 and 41-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 50 is/are allowed.
- 6) ☒ Claim(s) 32-33, 35-38, 41, and 44-49 is/are rejected.
- 7) ☒ Claim(s) 42 and 43 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/21/2009 has been entered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 32-33, 35-36, 44-46, 48 and 49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claims 32 and 48, the recitation "and at least one of the rasp guide and the retention rod projecting entirely through the opening in the rasp body" seeks to introduce new matter. It is noted that neither the rasp guide nor the retention rod project entirely through the opening in the rasp body.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 47 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 47, the recitation "wherein one of the retention rod and the means for removably engaging the retention rod extends through the opening in the rasp body" renders the claim vague and indefinite because the structure being recited is unclear. The retention rod is removably attached to the rasp body in the opening in the rasp body. Therefore, the distal end of the retention rod and the means for removably engaging the retention rod must be located in the opening in the rasp body.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 37-38 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Dunn et al. (US 4,759,350).

Dunn et al. disclose a system for resecting a proximal portion of a bone including: a finishing guide or resecting template 85 with a plurality of cutting slots or channels (90, 91, 92, 93); a bolt or retention rod having a first end removably connected to the template, the bolt projecting away from the bottom surface of the template; and a rasp having a first end slidably positioned within one of the plurality of channels (Figs. 11 and 12 and col. 13, lines 16-50).

Regarding claim 41, Dunn et al. disclose a second cutting guide or "second resecting template" 55 (Fig. 5 and col. 10, lines 6-59).

Regarding the recitation "for resecting at least a portion of a lateral or medial facet at a proximal end of a tibia", it is noted that a claim containing a "recitation with

respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). It is the examiner's position that the Dunn et al. resecting guide is fully capable of being placed on the proximal end of a tibia.

Claims 37-38 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Jenkins, Jr. (US 5,722,978).

Jenkins, Jr. discloses a system for resecting a proximal portion of a tibia including: an osteotomy guide 1 with a plurality of cutting slots or channels; a guide pin or retention rod 22 having a first end removably connected to the template, the pin projecting away from the bottom surface of the template; and a rasp having a first end slidably positioned within one of the plurality of channels (Figs. 7 and 8 and col. 13, lines 16-50).

Regarding claim 41, Dunn et al. disclose a second cutting guide or "second resecting template" 60 (Figs. 11-12, col. 9, lines 57-67 and col. 10, lines 1-12).

### ***Response to Arguments***

Applicant's arguments have been fully considered.

Regarding the rejections under 35 USC 112 first paragraph of claims 32-33, 35-36, 44-46, 48 and 49, it is noted that neither the rasp guide nor the retention guide project entirely through the opening in the rasp body.

### ***Allowable Subject Matter***

Claims 42 and 43 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 50 is allowed.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached at (571) 272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR  
December 31, 2009

/Anu Ramana/  
Primary Examiner, Art Unit 3775